

### **REMARKS**

Claims 1-23 are pending. By this response, claims 1, 2, 4, 13-18, 20, 21 and 23 are amended. Reconsideration and allowance based on the above amendments and following remarks are respectfully requested.

#### **§101 Rejection**

Claims 1-6 and 13-20 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

#### **Claim 1**

It is alleged in the Office Action that claim 1 is directed to software because there is no claimed structural or functional inter relationship between the software and other claimed elements of the computer which permits the computer program functionality to be realized. In response, Applicants have amended claim 1 and its corresponding dependent claims to include a feature of a server which is a physical article and includes various devices therein for performing the recited functions. Applicants respectfully submit that claim 1 and its dependent claims are within the confines of statutory subject matter. Accordingly, withdrawal of the rejection of claim 1 and its dependent claims is respectfully requested.

#### **Claim 13**

Claim 13 is rejected as claiming non-functional descriptive material being stored within a computer readable medium, i.e. a signal, and thus not directed to non-statutory subject matter. In response, Applicants respectfully submit that the defining law of claims directed to aspects of "signals" stems from *In re Nuijten*<sup>1</sup>. At the core of this case the Federal Circuit (CAFC) dictates

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<sup>1</sup> *In re Nuijten*, 84 U.S.P.Q.2d 1495 (Fed. Cir. 2007)

that a “signal” is not patentable subject matter because it is not a tangible article or commodity.

In first construing the term “signal,” the CAFC determined that a signal is more than just data. Some physical form for the signal is required, but the nature of the physical carrier is totally irrelevant to the issue of whether the signal constitutes statutory subject matter. Instead, the appropriate inquiry was whether a transitory propagating signal is within any of the four statutory categories: process, machine, manufacture, or composition of matter? The CAFC addressed these categories as follows.

### **1) Process**

The Supreme Court and this court have consistently interpreted the statutory term “process” to require action. A process consists of doing something, and therefore has to be carried out or performed. Nuijten noted that the claimed signal must be “encoded in accordance with a given encoding process.” However, the presence of acts recited in the claim does not transform a claim covering a thing—the signal itself—into one covering the process by which that thing was made. The signal claims are not directed to a process.

### **2) Machine**

The Supreme Court has defined the term “machine” as “a concrete thing, consisting of parts, or of certain devices and combination of devices.” A transitory signal made of electrical or electromagnetic variances is not made of “parts” or “devices” in any mechanical sense. While such a signal is physical and real, it does not possess concrete structure in the sense implied by these definitions. A signal is clearly not a machine.

### **3) Manufacture**

The majority noted that this statutory category was the most difficult to analyze here. Articles of manufacture are man-made, in the sense of having

been encoded, generated, and transmitted by artificial means. However, artificiality is insufficient by itself to render something a “manufacture.” Under the statutory use of the term “manufacture” and dictionary definitions, “articles” of “manufacture” are defined as tangible articles or commodities. A transient electric or electromagnetic transmission does not fit within that definition.

#### **4) Composition of matter**

The Supreme Court has defined “composition of matter” to mean “all compositions of two or more substances and all composite articles.” A signal comprising a fluctuation in electric potential or in electromagnetic fields is not a “composition[s] of matter.”

According to the above criteria set out by CAFC, a “signal” does not fall within an article of Manufacture because it is not tangible. Thus, items that are tangible are within the confines of an Article of Manufacture and therefore statutory. Thus, defining an item as tangible would preclude this item from being a signal in view of *In re Nuijten*.

This is presently the controlling law. Thus, applicants have amended the claim 13 to recite “[a] tangible computer readable recording medium” to comply with the current controlling law. As such claim 13 no longer reads on non-statutory subject matter. Accordingly, withdrawal of the rejection is respectfully requested.

#### **Prior Art Rejections**

Claims 1, 7 and 13 stand rejected under 35 U.S.C. §103(a) in view of Tanaka et al. (US 2001/0022624) and Wittke et al. (US 2004/0059705); claims 2-6, 8-12 and 14-18 under 35 U.S.C. §103(a) in view of Tanaka, Wittke and Romanik et al. (US 2003/0018802); and claims 19-23 under 35 U.S.C. §103(a)

in view of Tanaka, Wittke and Shibazaki (US 6,012,069). These rejections are respectfully traversed.

Each of independent claims 1, 7 and 13 refer to obtaining information from the image data sets classifying and specifying priority using the image obtained from image data sets. Applicants respectfully submit that Tanaka and Wittke fail to teach these features.

Tanaka teaches the creation of multiple directories from which a user selects appropriate directory to place an image. The directories are created from various information including image pickup condition or properties of the image. The directories are generalized directories based on the information obtained. Thus, a multitude of directories are created based on this information from which a user can select one or more of the directories to place an image. See paragraphs [0056], [0072], and [0093].

In contrast, Applicants claims refer to the information used to classify, prioritize and store image data sets so the information is retrieved from the image data sets themselves. Once the information is retrieved, the image data sets are stored based on this information based within a specific location. A user does not have to select from amongst a plurality of created directories as taught by Tanaka. Thus, Tanaka fails to teach or suggest, *inter alia*, classifying the image data sets into groups having a hierarchical structure of the specified information items according to the specified priority, as recited in independent claims 1, 7 and 13.

As stated above, classification and priority are based upon information obtained from the image data sets themselves. Furthermore, in Tanaka directories are created but the images themselves are not classified and stored in a specific folder in this classification based on the priority obtained from the information of the image data sets. It is the user in Tanaka after the directories are created that determines the storage location for an image and

thus the prioritization and classification are not based upon information from the image data sets but instead the user's own random thought process.

Further, Wittke teaches organization of information including hierarchical data sets. However, Wittke does not teach or suggest the specifics of Applicants claims in which information is obtained from the image data sets and used to classify and prioritize those image data sets. Wittke teaches nothing more than an organizational chart.

Applicants note that the claims are specific to how and where information is obtained and how data sets are classified are prioritized and stored based on the obtained information. These features must be taught. Generalized teachings of organizational structure do not teach the specifics of Applicants claims.

Therefore, Wikkte fails to teach specifying a portion of or all of the information items of the accompanying information to be used for image classification, and for specifying priority or model the specified information items, as recited in context of independent claims 1, 7 and 13.

In view of the above, Applicants respectfully submit that the combination of Tanaka and Wikkte fail to teach each and every feature of independent claims 1, 7 and 13. Further, Romanki and Shibazaki fail to remedy the deficiencies of Tanaka and Wikkte as each of these references are provided to teach aspects of the dependent claims. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

### Conclusion

For at least the above reasons Applicants respectfully submit claims 1-23 are distinguishable over the cited art. Favorable consideration and prompt allowance are earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad J. Billings Reg. No. 48,917 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

By   
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